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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/436,656 | 11/09/1999 | KENJI TAGAWA | 00177/530318 | 6961 |

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| EXAMINER |
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O'CONNOR, GERALD J

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| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,656

Applicant(s)

Tagawa et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 13, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24, 26-28, and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26-28, and 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 9, 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on January 13, 2005 in reply to the previous Office action, mailed October 20, 2004.
2. The addition of method claims 49-54 by applicant in the reply filed January 13, 2005 is hereby acknowledged.

Election/Restriction

3. Newly submitted method claims 49-54 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention defined by claims 49-54 (Invention II) is related to the invention defined by claims 22-24, 26-28, and 43-48 (Invention I), as process and apparatus for its practice. The inventions are distinct if it can be shown that *either*: (1) the process as claimed can be practiced by another, materially different apparatus, or by hand, *or* (2) the apparatus as claimed can be used to practice another, materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another, materially different apparatus, such as an apparatus having no controller, the step of “controlling” being performed manually by the user/operator.

4. Since applicant has received an Office action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly presented claims 49-54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 22-24, 26-28, and 43-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et al. (US 5,870,467). Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions. See MPEP §2114.

Imai et al. show a data conversion apparatus 100 comprising: a data transmission/receiving section/means 11; a data format judging section/means 3; an attribute information obtaining section/means 4; a user ID storage section/means storing identification information identifying the user of the data conversion apparatus (a user ID identifying the user of the data conversion apparatus being necessarily, thus inherently, present in order to perform the disclosed “authentication”); a ciphering section/means 132 for ciphering the attribute information (ciphering being necessarily, thus inherently, present in order to “protect” the data in the manner disclosed); a data format conversion section/means 5 for adding the ciphered attribute information and identification information to the audio contents; and, a controller 1, wherein the data transmission/receiving section/means of Imai et al. includes a data read-out portion 6 and a network interface 102. See, in particular, Figure 11.

Regarding claims 23 and 44, the data conversion apparatus of Imai et al. further comprises a data outputting section/means 6.

Regarding claims 24 and 45, the data conversion apparatus of Imai et al. further comprises a recording section/means 105 and a charging section 104.

Regarding claims 26-28 and 46-48, the recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions. See MPEP §2114.

Response to Arguments

7. Applicant's arguments filed Jan 13, 2005 have been fully considered but are not persuasive.

8. Regarding the argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant (e.g., "superdistribution"), it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

9. Regarding the argument that the Imai et al. fail to disclose certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., obtaining attribute information by performing a CDDB-type of remote audio CD database lookup to identify a normal, non-super-distribution, audio CD) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Regarding the argument that Imai et al. does not disclose all of the recited functional language recited by applicant's apparatus claims relative to the specific copyright/data protection scheme/format known as "superdistribution" (though "superdistribution" is specifically mentioned by Imai et al.) a recitation of the intended use of the claimed invention must result in a *structural* difference between the *claimed* invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. As long as the prior art structure is *capable* of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

11. Regarding the argument that functional language must be considered (i.e., not ignored), and that the examiner has simply ignored applicant's functional language, functional language must indeed be considered, and the entirety of applicant's functional language has, in fact, been duly considered, and *no* recitations, functional or otherwise, have been ignored.

12. Regarding the argument that functional language can necessitate structure in apparatus claims, functional language can indeed necessitate structure, but the claim would read on *any equivalent* structure of the prior art capable of performing the recited functions, no matter how different that "equivalent" structure might be from the *disclosed* invention/structure of applicant.

13. Regarding the argument that inherent characteristics must necessarily be present, and that a mere possibility of presence is insufficient, applicant is correct, but with functional language, it is the *capability* to perform the recited function that must be necessarily present, not the *function* itself. The function need not be *performed* in order to be *capable* of being performed. Again, as long as the prior art structure is *capable* of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

14. Regarding the argument that the attribute information obtaining section/means 4 of Imai et al. is incapable of performing the functionally recited intended use of, “identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section,” the attribute information obtaining section/means 4 of Imai et al. performs the steps of *identifying*¹ the audio contents of the data (it necessarily ascertains/determines the nature of the data, that the data is digital data in a recognizable, coherent, useable format, as opposed to random background noise) and obtaining attribute information (e.g., the size of the file/dataset, the bps reception rate, etc.) corresponding to the identified audio contents (the file/dataset) from the external equipment via a data transmission/receiving section (obviously it necessarily sends and receives data, thus, is inherently capable of transmitting and receiving data via a data transmission/receiving section).

15. Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of storing identification information identifying the user of the data conversion apparatus, the data conversion apparatus 100 of Imai et al. is indeed capable of storing identification information identifying the user of the data conversion apparatus, since a user ID identifying the user of the data conversion apparatus is necessarily, thus inherently, present in order to perform the disclosed “authentication” (authentication being the determination/establishment of identity).

¹ Ascertaining the origin, nature, or definitive characteristics of (*The American Heritage® Dictionary of the English Language, Third Edition*, Houghton Mifflin Company, 1992).

16. Regarding the argument that the apparatus of Imai et al. authenticates a program 106, not the user, therefore, does not comprise a user ID storage section storing identification information of the user of the data conversion apparatus, the program 106 is being used by the user, therefore, the identification/authentication information of the program *is* the identification information of the user. The two are uniquely and inseparably associated and logically attached. Therefore, the apparatus of Imai et al. indeed includes a user ID storage section storing identification information of the user, as broadly claimed by applicant. Note that the claim does not require, for example, the actual name of the individual operating the system, but reads merely on storing any information that serves to identify that user. Again, because the claim is so broad, the information need not even be unique. If it were the user's name being stored, the claim would read on simply storing the not-necessarily-unique name, for example, "John Smith," the identification information of the user. Regarding the term "user-ID" specifically, note that the term merely requires any general identification information regarding the user, nothing more, though it appears applicant may be reading more into the term than it requires. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. Regarding the argument that the ciphering section 132 of Imai et al. does not encipher the attribute information and identification information, the ciphering section 132 of Imai et al. indeed enciphers the attribute information and identification information, or it could not

accomplish the tasks that it performs. See, for example, columns 9 and 10, and columns 19 and 20. In other words, if the data were not enciphered, it would not be protected, and protecting the protected data is the express point of the entire system of Imai et al.

18. Regarding the argument that Imai et al. fails to disclose sections for recording and charging, Imai et al. indeed disclose a recording section/means 105 and a charging section 104.

19. Regarding the argument that the data transmission/receiving section of the data conversion apparatus 100 of Imai et al. fails to include a data read-out portion and a network interface, the data transmission/receiving section of Imai et al. indeed includes a data read-out portion 6 and a network interface 102. See, in particular, Figure 11.

20. Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of reading data out of a disc medium, the data conversion apparatus 100 of Imai et al. is indeed capable of reading data out of a disc medium, and the examiner specifically notes that audio contents of a CD are considered "data in a disc medium."

21. Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of recording superdistribution format data, the data conversion apparatus 100 of Imai et al. is indeed capable of recording superdistribution format data, as that is one of its explicitly disclosed intended purposes. Moreover, again, as noted above, it is well settled that the

disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory.

See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

22. Regarding the argument that all functional language must be considered in claims 43-48 because the claims are written in means-plus-function format, claims 43-48 do indeed define *structure* in means-plus-function format, but, additionally, still recite intended usage as well, and the intended usage still need not be explicitly disclosed in the reference if the claimed *structure*, as disclosed in the reference, is inherently *capable* of performing the claimed *usage*.

For example, the recitation, “a ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means” (claim 43, lines 18-19) includes both structure defined in means-plus-function language, “a ciphering means” (which recitation is considered equivalent to the more literal/traditional, “a means for ciphering,” as explained in MPEP §2181), as well as an intended usage of the “means for ciphering,” that being, “for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means.”

Note that, even if defined in means-plus-function format, apparatus claim limitations are still drawn to *structure*, and the structure in a reference, to be anticipatory, can *either* be the same as, *or equivalent to*, the disclosed structure of the claimed invention. See MPEP §2114, which states, in part, “that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification.”

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to the disclosure.

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

PLEASE TAKE NOTICE that on April 14, 2005 the examiner's telephone and facsimile numbers will be changing, to (571) 272-6787 and (571) 273-6787, respectively.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183, or, beginning April 14, 2005, at (571) 272-6788.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (not changing). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

March 30, 2005

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(3-30-05)" in parentheses.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627